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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,848	12/20/2001	John William Tobin	F6145(C)	2553

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EXAMINER	
WEIER, ANTHONY J	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,848	TOBIN, JOHN WILLIAM	
	Examiner	Art Unit	
	Anthony Weier	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Cirigliano et al.

Cirigliano et al discloses a process wherein tea extract is heated (e.g. 195 F or about 90 C; col. 3, lines 37-47) and stored and later mixed with water (at 45 C; e.g. col. 2, line 46) to prepare a beverage on demand (e.g. claim 6 of Cirigliano). It should be noted that under such conditions the beverage would contain greater than 0.1% extract (as called for in claim 9). It is considered inherent that said tea beverage would be translucent and not comprise visible particles of extract due to the processing employed in Cirigliano, particularly in ending further microbial activity.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornelius taken alone or with Kappaneberg.

Cornelius discloses a method for making a beverage comprising heating a beverage extract within a beverage brewing machine (see Figures 1 and 2, particularly holding tank 14; col. 2, line 41 – col. 3, line 5) wherein said heated beverage extract is mixed with a solvent (i.e. water) to produce a beverage on demand (e.g. coin-operated machine releases coffee extract to mix with water, see col. 4, lines 12-28). Cornelius further discloses an embodiment wherein the coffee extract comprises 15-30% of the final beverage (which reads on the range called for in instant claim 9; col. 4, line 21). It is considered inherent that the heating and preservation step employed therein would provide an extract and subsequent coffee beverage which is translucent and does not comprise of visible particles due to the processing employed therein which would inhibit further microbial activity.

Cornelius is silent regarding the particular temperature that the beverage extract is heated to prior to mixing with water. However, such determination would have been well within the purview of a skilled artisan, and, absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have achieved such holding temperature as a matter of preference depending on the particular temperature controls available, the cost involved, etc. Nevertheless, it is not uncommon to heat and store coffee extract (prior to further use) at temperatures as called for in the instant claims. For example, Kappaneberg teaches heating coffee extract to a temperature of 90 C to pasteurize same (with or without glycerin; see page 1, col. 1., lines 13-34; page 1, col. 2, lines 5-30). It would have been

further obvious to have heated said coffee extract to such temperature for increasing the shelf-life of same.

Cornelius is silent regarding the particular temperature of the solvent. Cornelius does disclose adding to the coffee extract hot and cold water (see Figure 2) and also discloses the beverage wherein "the temperature may be varied to suit the taste of the purchaser" (col. 4). Clearly, the temperature of the beverage may be varied by the temperature of water added and/or the holding temperature of the coffee extract itself. Such determination of attaining a certain temperature in the final beverage by manipulating the amount and temperature of the solvent and coffee extract would have been well within the purview of one skilled in the art. Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have employed the solvent temperature as set forth in the instant claims as a matter of preference depending on, for example, the particular beverage temperature that suits the taste of the purchaser.

Cornelius is silent regarding the beverage comprising, specifically, less than 45% by weight of the heated solvent. However, although Cornelius does disclose a suggested coffee extract content of 15-30% in the final beverage, same is not limited to such amounts. In fact, Cornelius discloses that the coffee extract simply be of a concentration "too high for consumption" (col. 2, lines 43-46). Clearly, this would include a concentration of coffee extract that would require amounts of solvent as called for in the instant claims (e.g. less than 45%) to achieve a coffee which may be consumed. Absent a showing of unexpected results, it would have been further obvious

to have arrived at such amount as a matter of preference depending on, for example, the amount of space available for storing the coffee extract, the cost involved, etc.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied in paragraph 2 above further in view of either one of JP 4-45745 or Weisberg et al.

If it is shown that Cornelius does not provide a process wherein the product is translucent and does not comprise visible particles of extract, the following should be noted. JP 4-45745 teaches providing clear coffee extract by adding an enzyme after heating same and would inherently provide for an absence of visible particles in the extract and subsequent beverage (if water added). Weisberg et al teaches a method of preparing a coffee extract which is clear and sedimentless (e.g. claim 3 in Weisberg et al) and which would be clear and sedimentless upon the addition of water. It would have been obvious to one having ordinary skill in the art at the time of the invention to have employed such enzyme or extraction conditions as set forth in either one of JP 4-45745 and Weisberg et al, respectively, to attain an aesthetically appealing coffee beverage.

4. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cirigliano et al as applied in paragraph 1.

Cirigliano et al is silent regarding the use of less than 45% by weight heated solvent. In particular, Ciricgliano et al discloses that the extract may be diluted with sufficient water to comply with the desired strength to meet consumer preference (col. 3, lines 21-24). It would have been obvious to one having ordinary skill in the art at the

time of the invention to have arrived at such solvent amount (or amount of dilution) as a matter of preference depending on the particular concentration of the tea extract to begin and depending on the level of tea strength desired by the consumer.

5. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cirigliano et al in paragraph 1 taken together with either one of Tse or Lindsey.

If it is shown that Cirigliano et al does not provide a process wherein the product is translucent and does not comprise visible particles of extract, the following should be noted. It is well known to provide tea extracts or beverages which are clear and free of precipitates by heating and filtration as taught, for example, in Tse (e.g. Example 1). Lindsey teaches a method for preparing a tea concentrate that is clear and free of turbidity. It would have been obvious to one having ordinary skill in the art at the time of the invention to have employed techniques as set forth in either one of Tse or Lindsey, to attain an aesthetically appealing tea beverage.

Response to Arguments

6. Applicant's arguments with respect to the instant claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier
February 17, 2005